

This Page Is Inserted by IFW Operations  
and is not a part of the Official Record

## **BEST AVAILABLE IMAGES**

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images may include (but are not limited to):

- BLACK BORDERS
- TEXT CUT OFF AT TOP, BOTTOM OR SIDES
- FADED TEXT
- ILLEGIBLE TEXT
- SKEWED/SLANTED IMAGES
- COLORED PHOTOS
- BLACK OR VERY BLACK AND WHITE DARK PHOTOS
- GRAY SCALE DOCUMENTS

**IMAGES ARE BEST AVAILABLE COPY.**

**As rescanning documents *will not* correct images,  
please do not report the images to the  
Problem Image Mailbox.**

## REMARKS

Applicants appreciate the indication of allowable subject matter in the present application.

The amendments of the after-final response filed November 12, 2003 were not entered as indicated by the Advisory Action mailed December 2, 2003. Applicants hereby file this RCE to have the rejections reconsidered in view of the below remarks.

Claims 31, 33-34, 37-42, 54, 57, 60-62, 64, and 67-70 stand rejected under 35 USC 102(e) for anticipation by U.S. Patent No. 5,239,260 to Widder et al

Applicants respectfully traverse the rejection and urge allowance of the present application.

Referring to claim 31, it is stated on pages 2-3 of the Office Action that Widder discloses an engagement probe 20. It is further alleged that any one of the corner edges formed at the bottom portion of engagement probe 20 disclose the claimed apex and any line formed by the truncated pyramid shown at the far edges of contact 22 discloses the knife-edge line. Applicant disagrees.

Applicants submit a copy of the dictionary definition of "knife-edge" as "a sharp narrow edge or margin like that of a knife," or "a narrow ridge." As set forth in col. 4, lines 45-48 the structure 20 is in the shape of a **pyramid**. Further, it is disclosed in line col. 4, lines 45- 58 that reference 22 of the bottom of the pyramid 20 is a *contact* **point** 22 formed on the tip of pyramid 20.

It is clear from the express teachings of Widder that structure 20 is a pyramid having a point to contact a pad. There is absolutely no teaching in Widder that the corner edges or any line of structure 20 may be fairly considered to teach or suggest a sharp narrow

edge or narrow ridge of the knife-edge line as claimed. Fig. 1 clearly illustrates the lower portions of structure 20 being formed by obtuse angles which in no fair interpretation disclose or suggest the claimed knife-edge line. Further, a contact point as clearly disclosed in Widder fails to disclose or suggest the claimed knife-edge line configured to removably engage a single conductive pad as claimed. Positively-recited limitations of claim 31 are not shown nor suggested and claim 31 is allowable for at least this reason.

The Examiner's interpretation of Widder is contrary to the express and explicit teachings of the Widder reference. In the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification in a non-final action of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R. §1.104(c)(2). In particular, 37 C.F.R. §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicants respectfully request clarification of the rejections with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a non-final Action if any claims are not found to be allowable.

The claims which depend from independent claim 31 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, the Office Action on page 3 identifies the bottom portion of 32 as allegedly disclosing the claimed penetration stop plane of claim 33. Applicants disagree. It is clear in Widder the reference 22 comprises a **contact point**. The Widder reference discloses vibration to establish the **contact** of the contact point 22 with pad 12. Widder fails to disclose or suggest limitations of claim 33 and claim 33 is allowable for this additional reason.

Page 4 of the Action states that limitations of claim 34 are inherent. There is no penetration stop plane let alone the specifically claimed tip being spaced a distance from the penetration stop plane of about one-half the thickness of the conductive pad which the apparatus is adapted to engage. Fig. 1 clearly disclosed a much greater distance between point 22 and a surface 32 than the thickness of pad 12. The Examiner's reliance on inherency is misplaced. The Examiner is reminded that, "in relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Widder fails to disclose or suggest any penetration stop plane teachings let alone the specific configuration of claim 34. The allegedly inherent characteristics do not necessarily flow from the teachings of Widder and the rejection of claim 34 is improper for this additional reason.

Claim 68 recites the substrate comprising a semiconductor substrate and the engagement probe comprises semiconductor material of the semiconductor substrate. The reliance upon inherency as set forth on page 5 in support of the rejection of claim 68

is improper. Numerous other configurations of structure 20 comprising material other than semiconductor material of a semiconductor substrate are possible. Accordingly, the reliance upon inherency in support of the rejection of claim 68 is improper in view of the above authority.

Referring to the rejection of independent claim 54, the prior art fails to disclose or suggest the probe having an outer surface comprising an apex in the form of at least one **knife-edge line**. The **pyramidal structure 20** and **contact point 22** fail to disclose or suggest the claimed knife-edge line. Claim 54 is allowable for at least this reason.

The bottom portion of layer 32 of Widder also fails to disclose or suggest the positively-claimed penetration stop plane. Widder discloses contacting the pad using the **contact point 22** and there are absolutely no teachings of record that the layer 32 operates as a penetration stop plane.

Numerous limitations of claim 54 are not shown nor suggested by the prior art. Applicant requests clarification of any rejection of claim 54 in a non-Final Action if such claim is not allowed.

The claims which depend from independent claim 54 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, claim 70 recites the engagement probe comprises semiconductor material formed from a semiconductor substrate. The reliance upon inherency as set forth on page 5 in support of the rejection of claim 70 is improper. Numerous other configurations of structure 20 comprising material other than semiconductor material of a

semiconductor substrate are possible. Accordingly, the reliance upon inherency in support of the rejection of claim 70 is improper in view of the above authority.

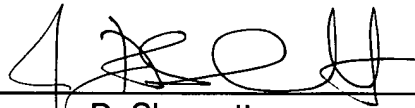
Applicants hereby add new claims 73-74 which are supported at least at page 13, line 22 through page 14, line 13 of the originally-filed application.

Applicants request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Dated: 12/29/03

By:   
James D. Shaurette  
Reg. No. 39,833

# Webster's Third New International Dictionary

OF THE ENGLISH LANGUAGE  
UNABRIDGED

*A Merriam-Webster*  
REG. U. S. PAT. OFF.

WITH SEVEN LANGUAGE  
DICTIONARY

---

VOLUME II

H to R



ENCYCLOPÆDIA BRITANNICA, INC.

*Chicago, London, Toronto, Geneva, Sydney, Tokyo, Manila*

EL 979952518

COPYRIGHT © 1981 BY G. & C. MERRIAM CO.

PHILIPPINES COPYRIGHT 1981 BY G. & C. MERRIAM CO.

WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY  
PRINCIPAL COPYRIGHT 1961

*All rights reserved. No part of this work covered by the copyrights hereon may be reproduced or copied in any form or by any means—graphic, electronic, or mechanical, including photocopying, recording, taping, or information and retrieval systems—without written permission of the publisher.*

Standard Book Numbers:

0-87779-201-1 (blue Sturdite)

0-87779-206-2 (Imperial Buckram)

MADE IN THE UNITED STATES OF AMERICA

34RMCN81



